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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,966	11/26/2003	Jan Chipchase	852.0024.U1(US)	9005
29683 7590 04/30/2007 HARRINGTON & SMITH, PC 4 RESEARCH DRIVE SHELTON, CT 06484-6212			EXAMINER DAO, MINH D.	
			ART UNIT 2618	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/722,966	Applicant(s) CHIPCHASE ET AL.	
	Examiner MINH D. DAO	Art Unit 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 01/31/07 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-21,23,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gouzman et al. (US 6,762,749) in view of Marcus et al. (US 2005/0093846) and further in view of Rosenberg et al. (US 5,691,898).

Regarding claim 1, Gouzman teaches an electronic device, having an exterior surface, the electronic device (see figs. 5A, 5B) comprising: an actuator (see fig. 3; pin actuators 108s; col. 18, lines 57-65) for providing, a first texture at a first portion of the exterior surface of the electronic device and for providing, a second texture at the first portion of exterior surface of the electronic device (see figs. 6s-10s. In this case, the position of the pins such as extended or retracted reads on the first and the second texture of the

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present invention respectively) a user interface for changing the status of the electronic device from a first status to a second status (see figs. 5A, 5B, items 202s, 204s).

However, Gouzman does not mention that the actuator provides the first texture at the first portion when the electronic device is in the first operational mode status, and wherein the actuator provides the second texture at the first portion when the electronic device is in the second operational mode status. Marcus, in an analogous art, teaches a human interface system that provides different levels of tactile feedback, actuated by actuator, to a user to indicate different events of interest (see section [0075]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the above teaching of Marcus to Gouzman in order for user of the combined system to tactively discriminate between desired functions as taught by Marcus (see abstract).

Still regarding claim 1, Gouzman and Marcus do not disclose a processor operable to enable the actuator during the first status and disable the actuator during the second status. Rosenberg, in an analogous art, teaches a computer peripheral system that includes a switch to enable and disable actuators by a user (see abstract; fig. 2; col. 14, line 33 to col. 15, line 22). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the above teaching of Rosenberg to Marcus and Gouzman in order for the combined system to allow user to enable or disable the actuators as desired.

Regarding claim 2, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein the first texture provides discontinuities in the first portion of the exterior surface (see figs. 6s-10s).

Regarding claim 3, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein the first texture feels bumpy or rough to the touch (see Gouzman, figs. 6s-10s).

Regarding claim 4, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 3, wherein the second texture feels relatively smooth to the touch (see Gouzman, figs. 6s-10s).

Regarding claim 5, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein the actuator continuously provides the first texture at the first portion of the exterior surface of the electronic device while the electronic device has the first status (see Gouzman, figs. 6s-10s).

Regarding claim 6, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 5, wherein the actuator continuously provides the

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second texture at the first portion of the exterior surface of the electronic device while the electronic device has the second status (see Gouzman, figs. 6s-10s).

Regarding claim 7, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein the actuator comprises extendible projections, which are extended when the actuator is enabled and retracted when the actuator is disabled (see Gouzman, col. 7, lines 19-32; also see figs. 6s-10s).

Regarding claim 8, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein the actuator comprises extendible projections, which are extended when the actuator is disabled and retracted when the actuator is enabled (see Gouzman, col. 7, lines 19-32; also see figs. 6s-10s).

Regarding claim 9, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein the actuator comprises one or more polymer actuators (see col. 7, lines 19-32).

Regarding claim 10, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein the actuator comprises one or more stepper motors (see Gouzman, col. 11, lines 25-40).

Regarding claim 11, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein the electronic device comprises a plurality of actuators and the processor is operable to selectively enable the actuators (see Gouzman, fig. 3; pin actuators 108s; col. 18, lines 57-65).

Regarding claim 12, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein the first status of the electronic device is changeable to the second status only via user interface (see Gouzman, figs. 5A, 5B (items 202s, 204s) and associated text portions).

Regarding claim 13, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein the actuator when enabled is indicative of an operational mode of the electronic device (see Gouzman, fig. 3; pin actuators 108s; col. 18, lines 57-65). The extended position of the pin actuator of Gouzman reads on this limitation of the claim.

Regarding claim 14, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein immediate user attention is not necessary when the electronic device has the first status (see the combination of Gouzman Marcus and Rosenberg, figs. 5A, 5B (items 202s, 204s) and associated text portions).

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Regarding claim 15, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein the electronic device is operational when it has the first status and is non-operational when it has the second status (see Gouzman, col. 13, lines 29-34). In addition, as explained above, the extended and retracted positions of the pin actuators define a function inherently including operational and non-operational status of the present invention.

Regarding claim 17, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein the electronic device is being used as a gaming device when it has the first status (see Gouzman, col. 7, lines 37-48).

Regarding claim 18, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, wherein the exterior surface of the electronic device is directly accessible to the user (see Gouzman, fig. 5B).

Regarding claim 19, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1, operable as a mobile cellular telephone (see Gouzman, col. 1, lines 26-54).

Regarding claim 20, the combination of Gouzman Marcus and Rosenberg teaches an electronic device as claimed in claim 1 operable as an accessory for a mobile cellular telephone (see Gouzman, col. 1, lines 26-54).

Regarding claim 16, since Gouzman teaches that electronic device operable as a mobile cellular telephone, therefore the device of Gouzman inherently can be in a mute or not mute as it is a well known fact in the cellular industry.

Regarding claim 21, the combination of Gouzman Marcus and Rosenberg teaches a user-replaceable cover for an electronic device as claimed in claim 1, providing at least the first portion of the exterior surface of the electronic device and comprising the actuator (see Gouzman, figs. 5A, 5B (items 202s, 204s) and associated text portions). Since items 202s and 204s are parts of the system of Gouzman, they are replaceable.

Regarding claims 23 and 24 the claims include the limitations of claim 1, and therefore is interpreted and rejected for the reasons set forth in the rejection of claim 1.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by Hunt et al. (US 7,031,761).

Regarding claim 22, Hunt teaches a user-replaceable cover for an electronic device, the cover comprising: a housing forming an exterior surface, wherein the housing is adapted to be removed by a user from the electronic device and replaced; means for providing, when enabled, a first texture at a first portion of the exterior surface; and an interface connected to the housing for forming an electrical connection with the electronic device (see fig. 2; col. 3, line 13 to col. 3, line 62).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D. DAO whose telephone number is 571-272-7851. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW ANDERSON can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Minh Dao *md*
AU 2618
April 19, 2007


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